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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,423	08/28/2003	Peter R. Anderson	47079-0232	7233

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EXAMINER
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WILLIAMS, ROSS A

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/650,423		ANDERSON ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Ross A. Williams		3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 11 and 16 - 31, drawn to a method of configuring a gaming machine for play, classified in class 463, subclass 29.
- II. Claims 12 - 15, drawn to a method of playing a gaming machine, classified in class 463, subclass 16.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as an apparatus and a method for configuring a gaming machine such as a slot machine based upon select options for game play. . In the instant case, subcombination II has separate utility such as a method for a player to play a slot machine. See MPEP § 806.05(d).

During a telephone conversation with Michael Blankstein on 8/2/2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 – 11 and 16 - 31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12 – 15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The term "optimum" in claims 5, 11 and 20 is a relative term that renders the claims indefinite. The term "optimum" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Accordingly the term will not be given patentable weight in determining the scope of the claims.

The term "substantially" in claims 6, 9, 12, 21, 22, 27 and 31 is a relative term that renders the claims indefinite. The term "substantially" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Accordingly the term will not be given patentable weight in determining the scope of the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 3713

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 4 – 6, 22, 24 – 27, 29 – 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Gauselmann (US 6,884,173).**

**Claim 1:** Gauselmann discloses a method of configuring electronic game machines (EGMs) by an operator for game play. The operator physically initializes an EGM configuration program, wherein the configuration program presents to the operator a plurality of different configuration options. The configuration options are shown on a menu driven display screen on the machine (1:35 – 45). The operator may also configure the EGMs remotely by means of a data network (1:46 – 49). The configuration program as displayed on the EGM can be seen in FIG 6 of Gauselmann. It can be seen that for one single game theme such as Game “X” the operator can configure what denomination that EGM will function as (i.e. Denom I, II, III, etc). The operator can also select how many reels the EGM will use. The screen displays the available values for the Maximum number of paylines, how much can be bet per payline, and the average payout percentage or mathematical models. The operator is able to configure the EGM to operate according to the selected parameters (4:10 – 16). Thus, it is disclosed that the EGM is configured based upon the selection of first and second maximum pay line values

**Claim 4:** Gauselmann discloses the use of a touchscreen display to configure an EGM. The touchscreen display presents to the operator the option of selecting various payline values and denomination values. Gauselmann discloses that the game

Art Unit: 3713

machine uses mechanical buttons that the player can press to actuate a max bet functionality (Gauselmann 2:54 – 61). The Examiner takes the position that it is well known in the art that a max bet button also corresponds to the player wagering on the maximum number of payline possible. This is a common feature that enables to player to quickly wager the maximum amount of money on all the paylines. Thus Gauselmann discloses the use of mechanical buttons that correspond to the configured first or second maximum payline value during game play utilizing the configured first or second denomination values.

**Claim 5:** Gauselmann discloses that the EGM is designed to have selectable values that are configured by the EGM designer. These values correspond to the number of available paylines and the denominations of the machine (FIG 6). These values are inherently optimum values.

**Claim 6:** Gauselmann discloses that the configuration screen displays multiple (i.e. first and second) maximum payline values (FIG 6). As can be seen these values are “substantially” different from each other.

**Claims 22 and 24, 25, 27, 29 and 30:** Gauselmann discloses a video display (Gauselmann FIG 1), a plurality of mechanical buttons (Gauselmann FIG 1), an EGM that inherently possesses a controller comprising a processor and memory coupled to the processor as is well known in the art. Gauselmann discloses the displaying of first and second plurality of maximum payline values on a video display. Gauselmann specifically discloses 4 different payline options which one can define or position these payline options into as many different groups as one can imagine. The operator can

select these payline values and the EGM detects this selection and thus will configure the EGM according the selected first and second payline values that were selected (Gauselmann 3:54 – 57).

Gauselmann discloses the displaying of a first plurality of math models that are selectable by the operator and configuring the EGM based upon them. Gauselmann discloses math models that can be viewed as payline values (Gauselmann FIG 6). As seen in FIG 6 the operator can select various paylines and then has the option of selecting the same payout percentages. Thus the payout percentages can be substantially the same for different maximum payline values.

**Claims 26 and 31:** Gauselmann discloses the detection of a save indication displayed on the screen (Gauselmann 4:46 – 51). Gauselmann discloses that the game machine uses mechanical buttons wherein the player can press to actuate a max bet functionality (Gauselmann 2:54 – 61). The Examiner takes the position that it is well known in the art that a max bet button also corresponds to the player wagering the maximum amount of credits or money on the maximum number of payline possible. This is a common feature that enables to player to quickly wager the maximum amount of money or credits on all the paylines. Thus, Gauselmann discloses the use of mechanical buttons that correspond to the configured first or second maximum payline value during game play utilizing the configured first or second denomination values. Thus depending upon what selected denomination mode the EGM is operating in the player is able to select a mechanical “max bet” button to make his max credit wager on

Art Unit: 3713

the maximum number of paylines. The various payline values can also be thought of as math models as discussed above in references to claims 22, 23 and 25.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 2, 3, 7 – 11 and 16 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gauselmann (US 6,884,173).**

**Claims 2 and 3:** Gauselmann does not disclose the displaying the first and second plurality of maximum pay line values in response to the operator selecting a first and second denomination value. However Gauselmann discloses the displaying of the denomination values at the same time the maximum payline values are displayed. (Gauselmann FIG 6). Gauselmann discloses a menu-based display that is used to configure an EGM. Gauselmann further discloses a form of a hierarchical menu display

wherein the configuration options may present a number of preselected settings for the operator to choose from (Gauselmann 4:40 – 43). Gauselmann also discloses that different variables may be associated with subsequent menus (Gauselmann 4:44 – 45).

It would be obvious to one of ordinary skill in the art to modify Gauselmann to display subsequent menus that describe selectable options in response to the selection of various options Gauselmann discloses the displaying of both denomination and maximum payline options at the same time. It is well known in the art of gaming to use hierarchical menu configurations as a way to present to the user a less complicated and user-friendly setup display.

**Claim 7:** Gauselmann discloses the detection of first and second game denomination values (Gauselmann 4:24 – 39), and the configuring of the EGM based upon the selection of these different denomination values (Gauselmann 4:24 – 39, 46 – 51). Gauselmann also discloses the displaying of other different manufacture-limited game configuration values such as reels, credits, and payout percentages simultaneously (Gauselmann FIG 6). However Gauselmann does not disclose that these manufacture-limited game configuration values are displayed in response to the detection of the operator selection of the game denomination values. Gauselmann discloses a form of a hierarchical menu display wherein the configuration options may present a number of preselected settings for the operator to choose from (Gauselmann 4:40 – 43). Gauselmann also discloses that different variables may be associated with subsequent menus (Gauselmann 4:44 – 45).

It would be obvious to one of ordinary skill in the art to modify Gauselmann to display subsequent menus that describe selectable options in response to the selection of various options Gauselmann discloses the displaying of both denomination and maximum payline options at the same time. It is well known in the art of gaming to use hierarchical menu configurations as a way to present to the user a less complicated and user-friendly setup display.

**Claims 8 and 9:** As can be readily seen from the disclosure of Gauselmann, the configuration screen displays multiple (i.e. first and second) maximum payline values and payback percentages. As can be seen these values are “substantially” different from each other.

**Claims 10 and 19:** As can be seen from the discussion above, Gauselmann discloses the use of an operator configuration mode that allows the operator to operate the game according to different denominations, operate with differing numbers of maximum paylines, and operate with differing payback percentages. These variables are all selectable by the operator by means of the configuration mode and display. Gauselmann discloses the detection of a save indication displayed on the screen (Gauselmann 4:46 – 51). Gauselmann discloses that the game machine uses mechanical buttons wherein the player can press to actuate a max bet functionality (Gauselmann 2:54 – 61). The Examiner takes the position that it is well known in the art that a max bet button also corresponds to the player wagering the maximum amount of credits or money on the maximum number of payline possible. This is a common feature that enables to player to quickly wager the maximum amount of money or

credits on all the paylines. Thus, Gauselmann discloses the use of mechanical buttons that correspond to the configured first or second maximum payline value during game play utilizing the configured first or second denomination values. Thus depending upon what selected denomination mode the EGM is operating in the player is able to select that actuate the mechanical "max bet" button to make his max credit wager on the maximum number of paylines.

**Claim 11 and 20:** Gauselmann discloses that the EGM is designed to have selectable values that are configured by the EGM designer. These values correspond to the number of available paylines and the denominations of the machine. These values are inherently optimum values that provide optimum game play.

**Claim 16:** Gauselmann discloses a video display (Gauselmann FIG 1), a plurality of mechanical buttons (Gauselmann FIG 1), an EGM that inherently possesses a controller comprising a processor and memory coupled to the processor as is well known in the art. Gauselmann discloses the displaying of first and second plurality of maximum payline values on a video display. Gauselmann specifically discloses 4 different payline options, which one can define or position these payline options into as many different groups as one can imagine. The operator can select these payline values and the EGM detects this selection and thus will configure the EGM according the selected first and second payline values that were selected (Gauselmann 3:54 – 57).

**Claim 17 and 18:** Gauselmann does not disclose that these manufacture-limited game configuration values are displayed in response to the detection of the operator

selection of the game denomination values. Gauselmann further discloses a form of a hierarchical menu display wherein the configuration options may present a number of preselected settings for the operator to choose from (Gauselmann 4:40 – 43).

Gauselmann also discloses that different variables may be associated with subsequent menus (Gauselmann 4:44 – 45).

It would be obvious to one of ordinary skill in the art to modify Gauselmann to display subsequent menus that describe selectable options in response to the selection of various options Gauselmann discloses the displaying of both denomination and maximum payline options at the same time. It is well known in the art of gaming to use hierarchical menu configurations as a way to present to the user a less complicated and user-friendly setup display.

**Claim 21:** Gauselmann discloses that the configuration screen displays multiple (i.e. first and second) maximum payline values. As can be seen these values are “substantially” different from each other.

**Claims 23 and 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gauselmann (US 6,884,173) in view of Walker (US 2003/0119479).**

**Claims 23 and 28:** Gauselmann does not specifically disclose the displaying of mathematical models that comprise probability tables. However Gauselmann does disclose the displaying of payback percentages, which are indicative of a certain probability that is associated with the game. Walker however discloses the customizing of a game machine wherein the player is able to customize select parameters of the

game and yet the game machine still provides the same payout percentages to the player despite the customizations (Walker Abstract). Walker also discloses that the game machine will display to the player tables of probabilities of various outcomes (Walker page 21: par 0271).

It would be obvious to one of ordinary skill in the art to modify Gauselmann in view of Walker to display probability tables to the operator. This would enable the operator be able to be better informed when configuring the gaming machine. The operator would be able to know probabilities that are associated with a certain customization to the gaming machine.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross A. Williams whose telephone number is (571) 272-5911. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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